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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,760	01/05/2007	Marcello Allegretti	4342-0118PUS1	6665
2292 7590 06/29/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
HABTE, KAHISAY				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
06/29/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/568,760

Applicant(s)

ALLEGRETTI ET AL.

Examiner

Kahsay T. Habte

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 17 is/are rejected.
- 7) ☒ Claim(s) 1 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 and 12-19 are pending in this application.

Response to Amendment

2. Applicant's amendment filed 06/17/2009 in response to the previous Office Action (01/14/2009) is acknowledged. Rejection of claims 1 and 12-17 under 35 U.S.C. § 112, first and second paragraph (items 6 and 7a-7c) and the prior art rejection under 35 U.S.C. 102(b) rejection have been obviated. Even though applicants overcome the prior art rejection by adding a proviso, the proviso lacks description.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 12, the negative proviso "with the proviso that: if R is H and R' are both H, then Ar is not-substituted phenyl....then Ar is not non-substituted phenyl" lacks description. Even a negative limitation requires description, *Ex Parte Grasselli*, 231 USPQ 393.

Note that there is no description of such proviso "if R1 is H and R' are both H, then Ar is not-substituted phenyl..... Applicants cannot simply create provisos and conditions out of the air. Cf *Ex Parte Westphall*, 26 USPQ2nd 1858; *In re Lukach*, 169 USPQ 795; *In re Maclean*, 172 USPQ 494; *Wagner v. Barger*, 175 USPQ 85; *In re Blaser*, 194 USPQ 122; *In re Baker*, 194 USPQ 470; *In re Kyser*, 200 USPQ 211; *In re Sichert*, 196 USPQ 209; *Ralston Purina v. Farmaco*, 227 USPQ 177; *In re Wertheim*, 209 USPQ 554, 565; *In re Drager*, 66 USPQ 249; *In re Baird*, 146 USPQ 579.

Applicants' analysis of the law in regard to *In re Johnson* is not agreed with. In *Ex Parte Grasselli*, applicants sought to avoid a 35 USC 102(b) anticipation by writing a proviso which excluded the prior art species, which proviso lacked any description. By contrast, in *In re Johnson*, 194 USPQ 187, 196, the fact situation was somewhat different. There, the claims were narrowed to avoid material lost in an interference. Since the fact situation here is the same as *Ex Parte Grasselli*, and different from *In re Johnson*, the former, and not the latter will be followed. The only thing that the examiner is saying is that a proviso must itself be described. The examiner has never required that a proviso even be used. The vast majority of amendments are tendered without use of proviso.

Objection

5. Claims 1 and 16 are objected to as being drawn to multiple inventions, but maybe allowable after complete search if the non-elected inventions are deleted.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kahsay T. Habte/
Primary Examiner, Art Unit 1624

June 25, 2009